

UNITED STATES DISTRICT COURT

Northern District of California

San Francisco Division

11 BARNES AND NOBLE, INC., et al.,

No. C 11-02709 EMC (LB)

12 v. Plaintiffs,

**ORDER REGARDING THE PARTIES'
JOINT DISCOVERY LETTER DATED
MARCH 28, 2012**

13 LSI CORPORATION, et al.,

[Re: ECF No. 94]

14 Defendants.

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16 Plaintiffs Barnes & Noble, Inc. and barnesandnoble.com LLC (collectively, “B&N”) filed the
17 instant action seeking a declaratory judgment of non-infringement and patent invalidity against
18 defendants LSI Corporation and Agere Systems, Inc. (collectively, “Defendants”). Original
19 Complaint, ECF No. 1.¹ Defendants answered B&N’s First Amended Complaint and brought
20 counterclaims against B&N for patent infringement. Answer and Counterclaims, ECF No. 62.

21 On March 28, 2012, the parties filed a joint letter describing a discovery dispute. 3/28/2012
22 Joint Letter, ECF No. 94. The current dispute involves B&N’s responses to four of Defendants’
23 “contention interrogatories” (the “Interrogatories”). *See* 03/28/2012 Joint Letter, ECF No. 94.² The

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25 ¹ Citations are to the Electronic Case File (“ECF”) with pin cites to the electronic page
26 number at the top of the document, not the pages at the bottom.

27 ² *See In re Convergent Technologies Securities Litigation*, 108 F.R.D. 328, 332 (N.D. Cal.
28 1985) (As Magistrate Judge Brazil explained: “[T]he phrase ‘contention interrogatory’ is used
imprecisely to refer to many different kinds of questions. Some people would classify as a

1 Interrogatories at issue are:

2 Interrogatory No. 9: Describe the full factual and legal basis for your contention that
3 you do not infringe, contribute to the infringement or induce the infringement of the
4 Asserted Patents, and have not infringed, contributed to the infringement or induced
5 the infringement of the Asserted Patents.

6 Interrogatory No. 13: State the full factual and legal basis for your contention that
7 LSI and Agere are estopped from construing the claims in the Asserted Patents in
8 such a way as to cover BN's activities and/or products, including but not limited to
9 identifying the alleged "prior statements, "prior conduct," or "admissions or other
10 statements made to the United States Patent and Trademark Office" to which you
11 refer in ¶ 94 of your Affirmative Defenses in your Answer and Affirmative Defenses
12 to Counterclaims [Dkt. No. 66].

13 Interrogatory No. 15: State the full factual and legal basis for your contention that the
14 Asserted Patents are not essential to the practice of Wi-Fi, 3G, or MP3 Standards, and
15 identify all evidence that supports your contention.

16 Interrogatory No. 16: State the full factual and legal basis for your contention that
17 your implementation of Wi-Fi, 3G, or MP3 Standards in the Accused Devices does
18 not infringe any of the Asserted Patents, and identify all evidence that supports your
19 contention.

20 *Id.* at 1. In its original responses, B&N declined to substantively respond to these Interrogatories in
21 part because it believed they were "premature in light of the timetable for discovery provided by the
22 Patent Local Rules." *Id.*, Exhs. 1, 2. After a series of discussions, B&N told Defendants that it
23 would serve supplemental responses to the Interrogatories by September 24, 2012, which is roughly
24 two months after Defendants' infringement contentions are due and the same day that B&N's
25 invalidity contentions are due. *Id.*, Exh. 7; 3/26/2012 Scheduling Order, ECF No. 92 at 3.

26 In the 3/28/2012 Joint Letter, Defendants do not suggest that B&N's proposal to serve
27 supplemental responses to the Interrogatories by September 24, 2012 is unreasonable, inappropriate,

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contention interrogatory any question that asks another party to indicate what it contends. Some
29 people would define contention interrogatories as embracing only questions that ask another party
30 whether it makes some specified contention. Interrogatories of this kind typically would begin with
31 the phrase 'Do you contend that . . . ?' Another kind of question that some people put in the category
32 'contention interrogatory' asks an opposing party to state all the facts on which it bases some
33 specified contention. Yet another form of this category of interrogatory asks an opponent to state all
34 the evidence on which it bases some specified contention. Some contention interrogatories ask the
35 responding party to take a position, and then to explain or defend that position, with respect to how
36 the law applies to facts. A variation on this theme involves interrogatories that ask parties to spell
37 out the legal basis for, or theory behind, some specified contention.").

1 or prejudicial in any way. *See id.* at 1-3.³ What, then, is the problem? Simply put, based upon their
2 previous discovery negotiations in this case, Defendants' counsel does not take B&N's counsel at
3 their word that B&N actually will serve supplemental responses by that date. *See id.* Defendants
4 sought a stipulation setting forth the September 24, 2012 deadline, but B&N refused to sign it. *See*
5 *id.*, Exh. 7. Thus, Defendants seek a court order setting forth the parties' agreed-upon deadline. *Id.*
6 at 2.

7 The court declines to provide one in this context. While the parties' agreed-upon September 24,
8 2012 deadline for B&N to serve supplemental responses to Defendants' Interrogatories strikes the
9 court as reasonable and appropriate, the court will not enforce the parties' discovery-related
10 agreements that have only been made through counsels' emails and have not been submitted as
11 finalized stipulations. *See Parrish v. Nat'l Football Players Ass'n*, No. C 07-00943 WHA, 2008 WL
12 3287030, at *6 (N.D. Cal. Aug. 6, 2008). And as B&N points out, Defendants may raise issues
13 regarding the timing or content of B&N's substantive responsive in September 2012, when B&N has
14 agreed to serve them.⁴

15 Accordingly, Defendants' request for a court order requiring B&N to provide supplemental
16 responses to Defendants' Interrogatories by September 24, 2012 is DENIED WITHOUT
17 PREJUDICE.⁵

19 ³ Rule 33 governs the use of contention interrogatories to discover the factual basis for
20 allegations in a complaint. "Courts using their Rule 33(a)(2) discretion generally disfavor
21 contention interrogatories asked before discovery is undertaken." *In re eBay Seller Antitrust*
22 *Litigation*, No. C07-1882 JF (RS), 2008 WL 5212170, at *1 (N.D. Cal. Dec. 11, 2008) (citing
23 *Tennison v. City & County of San Francisco*, 226 F.R.D. 615, 618 (N.D. Cal. 2005)). "In fact,
24 courts tend to deny contention interrogatories filed before substantial discovery has taken place, but
grant them if discovery almost is complete." *Id.* (citing *Fischer & Porter Co. v. Tolson*, 143 F.R.D.
93, 95 (E.D. Pa. 1992); *In re Convergent Technologies Securities Litigation*, 108 F.R.D. 328, 332-38
(N.D. Cal. 1985)).

25 ⁴ For instance, parties may file a joint discovery dispute letter if B&N fails to serve its
26 Interrogatory responses by the reasonable and appropriate deadline of its own choosing (September
27 24, 2012).

28 ⁵ Pursuant to Civil Local Rule 7-1(b), the court finds this matter suitable for determination
without oral argument.

1 **IT IS SO ORDERED.**

2 Dated: April 30, 2012



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 LAUREL BEELER
4 United States Magistrate Judge